

Application No.: 10/707,831
Amendment Dated: December 28, 2005
Reply to Office Action of: June 28, 2005

Attorney Docket No.: 28647.00002
Customer No.: 35161

REMARKS/ARGUMENTS

This Amendment is in response to the Non-Final Office Action mailed on June 28, 2005, for the present application, which has been reviewed. The present amended claims (5, 6, 8, 14, 17, 21 and 23) considered together with the following remarks, the arguments below and request for reconsideration are believed sufficient to place the application into condition for allowance. No new matter has been added to the application. Applicants express appreciation for the thoughtful examination by the Examiner. Support for the amendments can be found in the specification in paragraph [0021].

The present invention is a ball return device configured for use on a game table having a net such as table tennis. The device is a ramp placed parallel and adjacent to the entire length of a net on the game table as is shown in the figures and described in the accompanying text. End caps/brackets may be placed at the far edges of the net to further facilitate ball retrieval. Also, the ramp is configured not to exceed the height of the net.

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Rejection of Claims 5-9, 13-15 and 17-23 Under 35 U.S.C. § 103 Should Be Withdrawn

The present action rejects claims 5-9, 13-15 and 17-23 under 35 U.S.C. section 103(a) as being unpatentable over Cutrone (USPN 4,971,319) as previously applied in view of Shigeru (JP 10,192,469). Applicants respectfully traverse this rejection and request favorable reconsideration and withdrawal of this rejection. Further, Applicants submit this rejection is rendered moot by the foregoing amendments and the following comments.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings for a ball return device with the claimed specific properties. Second, there must be some reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2142.

As previously presented, there are a number of significant, material and functional differences between the present invention and the device described in Cutrone. Cutrone describes a device for use on a net of a tennis court. The Cutrone device is configured to dampen (slow) ball movement by making it out of netting. This is desired on a tennis court since a user would not like to have a tennis ball directed toward their feet potentially risking injury. This configuration merely "cause[s] a returned ball to move close to the player so that the player need not move a great distance to retrieve the returned ball." (col. 2, lines 66-68). In contrast, the present invention is configured to return the ball to the user, not merely closer.

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The present invention is not made obvious in view of Shigeru. Applicants respectfully submit that table tennis and tennis are very dissimilar sports as applied to the function of the present invention. It would not be obvious to combine teachings of the two sports anymore that it would be obvious to combine the teachings of foosball and soccer. In fact, there is no suggestion in either Cutrone or Shigeru to combine the teachings. Each sport is played on a very different environment. In tennis, a player must move all around the playing surface. In table tennis, the player must avoid the playing surface. As such, Cutrone applied to Shigeru teaches limited movement of a ball back onto the playing surface. This could result in increased risk of injury to a player. In contrast, the present invention teaches to direct the ball back towards the user behind the playing surface. To make this distinction clearer, claims 5, 6, 8, 14, 17, 21, and 23 have been amended to include the limiting term "rigid" (see paragraph [0021] for support) to distinguish it from the netting material of Cutrone.

Further, there are significant differences between the end brackets of Shigeru and the present invention. The Shigeru end brackets are on plane with and outside of the playing surface. This would typically result in the ball being retained within its base plate just outside of the playing surface. This shortcoming would not be improved by applying it to Cutrone in that the netted ramp portion would not meet the semicircular ball returning guide of Shigeru. In contrast, the present invention continuously joins the edge of the ramp member with the end brackets. The ramp member allows a ball to accelerate as it is deflected by the end brackets toward the player behind the playing surface.

Regarding the rejection of claims 8 and 21, to connect the ramp members, Applicants submit these claims as amended and for the reasons submitted herein are believed to be in condition for allowance.

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Regarding the rejection of claims 7 and 20, Applicants submit they depend from claims as presently amended are believed to be in condition for allowance.

Regarding the rejection of the hooks of claim 9, Applicants submit it depends from a claim that as presently amended is believed to be in condition for allowance.

Regarding the rejection of the support elements of claims 13 and 22, Applicants submit they depend from claims that as presently amended are believed to be in condition for allowance.

Regarding the rejection of the extensions of claims 18 and 19, Applicants submit they depend from claims that as presently amended are believed to be in condition for allowance.

Regarding the rejection of the kit form of claim 23, Applicants submit this claim as amended and for the reasons submitted herein is believed to be in condition for allowance.

In light of the above, Applicants respectfully submit they have addressed all aspects of the rejections under 103(a) and demonstrated that Applicants' invention, as presently claimed, is not anticipated nor suggested by Cutrone nor obvious as previously applied in view of Shigeru.

In light of the foregoing, Applicants therefore believe claims 5-9, 13-15 and 17-23 are in condition for allowance, and respectfully requests such allowance.

Rejection of Claims 10-12 Under 35 U.S.C. § 103 Should Be Withdrawn

The present action rejects claims 10 - 12 under 35 U.S.C. section 103(a) as being unpatentable over Cutrone (USPN 4,971,319) as previously applied in view of Shigeru (JP 10,192,469) as applied above in view of Vandeveld (USPN 4,919,421). Applicants respectfully traverse this rejection and request favorable reconsideration and withdrawal of this rejection.

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Further, Applicants submit this rejection is rendered moot by the foregoing amendments and the following comments.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings for a ball return device with the claimed specific properties. Second, there must be some reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2142.

Including the discussions of the referenced prior art above, Applicants further submit that Vandeveld teaches directing a ball toward the net and not towards a user on the playing surface. Further, there is no suggestion in Shigeru or Vandeveld to combine the ramps of Vandeveld with end brackets. As such, claim 10, as amended, is believed to be in condition for allowance.

Regarding the rejection of claims 11 and 12, Applicants submit they depend from claims as presently amended are believed to be in condition for allowance.

In light of the above, Applicants respectfully submit they have addressed the all aspects of the rejections under 103(a) and demonstrated that Applicants' invention, as presently claimed, is not anticipated nor suggested by Cutrone nor obvious as previously applied in view of Shigeru and Vandeveld.

In light of the foregoing, Applicants therefore believe claims 10-12 are in condition for allowance, and respectfully requests such allowance.

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CONCLUSION

Examiner noted that the prior art of record was considered pertinent to Applicants' disclosure. Applicants' have reviewed the prior art of record and submit it does not adversely bear on the patentability of the pending claims.

In light of the foregoing, Applicants respectfully submit they have addressed each and every item presented by the Examiner in this Office Action. Favorable reconsideration of all of the claims as amended is earnestly solicited. Applicants submit that the present application, with the foregoing claim and specification amendments and accompanying remarks, is in a condition for allowance and respectfully request such allowance.

In the event any further matters requiring attention are noted by Examiner or in the event that prosecution of this application can otherwise be advanced thereby, a telephone call to Applicants' undersigned representative at the number shown below is invited.

Respectfully submitted,

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